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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,126	08/23/1999	GEROLD MAHLER	F-6224	2441

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JORDAN & HAMBURG
122 EAST 42ND STREET
NEW YORK, NY 10168

EXAMINER

MCKANE, ELIZABETH L

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 01/15/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/319,126

Applicant(s)

MAHLER ET AL.

Examiner

Leigh McKane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 7-15 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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Claim Objections

1. Claims 9-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall refer to another claim in the alternative only and because a multiple dependent claim shall not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the subject matter of claims 5-8 is not disclosed in the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase et al (U.S. Patent No. 3,431,061).

Chase et al teaches a method of preserving wood wherein the wood is sealed within a Casing, thereby allowing the naturally occurring microorganisms to consume the remaining oxygen. Chase et al discloses that the level of oxygen is maintained at a value below about 0.5%

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after one to three days. See Abstract; col.1, lines 35-45; col.1, line 59-col.2, line 4; col.2, lines 23-30. The examiner submits that since the method of Chase et al is identical to that of the present invention, the oxygen and carbon dioxide levels would inherently reach the claimed levels since no oxygen is introduced into the sealed packages of wood.

The packaging material of Chase et al is disclosed to be flexible layers of thermoplastic material or scrap papermaker's felt which is made impermeable to oxygen. See col.2, lines 16-22. The sealed package may be protected with multiple layers of asphalt impregnated felt. See col.2, lines 37-43. This material is inherently impermeable to light. Furthermore, some of the thermoplastic materials employed by Chase et al are also inherently impermeable to light.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al.

Although Chase et al does not disclose minimizing the amount of air within the package before sealing, the reference does recognize that the microorganisms do not promote decay of the wood once the oxygen is consumed. Thus, it would have been obvious to one of ordinary skill in the art to minimize the amount of available oxygen in order to expedite the consumption of oxygen.

8. Claims 5, 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al in view of Wadas, Jr. (U.S. Patent No. 5,718,851)

As to claim 5, Chase et al teaches a variety of thermoplastic materials can be used as the cover but does not disclose if they are UV-resistant. See col.2, lines 16-22. Wadas, Jr. discloses a method of protecting wood wherein the wood is covered with a UV-resistant material (col.2, lines 49-52). Since Wadas, Jr. teaches that wood is susceptible to direct sun exposure, it would have been obvious to use a UV-resistant material in the cover of Chase et al.

With respect to claims 7 and 8, Chase et al discloses that several layers of material may be used to cover the wood, wherein the layers are "suitably sealed." See col.2, lines 23-30. The Examiner submits that one of ordinary skill in the art would have been apprised of "suitable" sealing means, such as welding and bonding.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al in view of Seidner (U.S. Patent No. 5,447,686).

Chase et al does not teach using a rigid container of hold as the storage means. Seidner et

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al discloses that it is known in the art to employ a ship's hold as a location for wood preserving. Since a hold allows for wood treatment during transit, it would have been obvious location for treating wood in the method of Chase et al.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al and Seidner as applied to claim 13 above, and further in view of Reeves et al (U.S. Patent No. 5,725,613).

The combination of Chase et al with Seidner fails to disclose using recovered exhaust gases in the treatment process. However, Reeves et al teaches that it was known in the art at the time of the invention to treat bulk material with recovered carbon dioxide. See col.7, lines 29-35. It would have been obvious to do so in the combination for economical use of carbon dioxide.

Allowable Subject Matter

11. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: The closes prior art, Chase et al and Wadas, Jr., fails to teach the use of a two-layered film having a black internal surface preventing light from entering and a white external surface reflecting light.

Conclusion

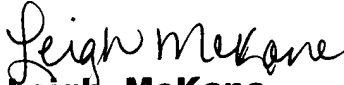
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meredith et al (U.S. Patent No. 6,063,336) teaches a method and apparatus for wood chip pasteurization within a sealed ship hold. JP 9-39811 discloses a method of wood storage within a sealed container having a protective gas atmosphere. Kozlik et al (Abstract of "Changes of the atmosphere during wood decay by fungi under conditions of stopped gas diffusion") teaches that lack of oxygen and the accumulation of carbon dioxide inhibits fungal growth on wood.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 703-305-3387. The examiner can normally be reached on Monday-Wednesday (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7719 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Leigh McKane
Primary Examiner
Art Unit 1744

elm
January 14, 2002